

## REMARKS

Claims 8 – 25 remain in the application and stand rejected. Claims 1 – 7 are previously canceled without prejudice as being drawn to a non-elected invention. Claims 8, 14, 17 – 19, 24 and 25 are amended by this proposed amendment.

The MPEP provides in pertinent part “the examiner should always look for enabled, allowable subject matter and communicate to applicant what that subject matter is at the earliest point possible in the prosecution of the application.”<sup>1</sup>

Claims 8 – 25 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. The rejection is respectfully traversed.

“*State Street Bank*<sup>2</sup> involved ‘a data processing system for managing a financial services configuration of a portfolio established as a partnership,’ and ‘[g]iven the complexity of the calculations, a computer or equivalent device [wa]s a virtual necessity to perform the task.’ *Id.* at 1371.”<sup>3</sup> In deciding *Comiskey* the CAFC concluded “that independent claims 17 and 46 (and their dependent claims) and dependent claims 15, 30, 44, and 58 recite **statutory subject matter** [and therefore] remand[ed] to the PTO to determine whether the addition of a **general purpose computer** or modern **communication devices** to *Comiskey*’s otherwise unpatentable **mental process** would have been obvious.”<sup>4</sup> So, in *Comiskey* the CAFC sets forth a bright line rule for determining whether claims encompass patentable subject matter. Specifically, claims

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<sup>1</sup> MPEP §2164.04 (emphasis original).

<sup>2</sup> *State Street Bank*, 149 F.3d at 1377.

<sup>3</sup> *In re Comiskey*, Case No. 2006-1286 (hereinafter *Comiskey*), bridging sentence, pages 12 – 13 (Fed. Cir., September 20, 2007).

<sup>4</sup> *Id.*, page 2, lines 14 – 18 (emphasis added).

“combining the use of machines with a mental process, claim patentable subject matter.”<sup>5</sup>  
As a result, the CAFC reversed and returned the *Comiskey* application to the PTO to consider obviousness of those statutory claims.

Claims 8 and 14 correspond to *Comiskey* claim 17<sup>6</sup>. Applying the *Comiskey* rationale to the claimed collaborative design system that includes “data generation module ...;” a collection of HTML template files and a “page generation module,” combines “the use of machines with a mental process, claim patentable subject matter.”<sup>7</sup> Therefore, under the *Comiskey* bright line rule, claims 8, 14 and claims depending therefrom “claim patentable subject matter.”<sup>8</sup>

Claims 17 – 19, 24 and 25 recite a “computer program product for managing a **system**, said **computer** program product comprising a **computer usable medium** having **computer** readable program code stored thereon,”<sup>9</sup> ... .” Certainly claims 17 – 19, 24 and

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<sup>5</sup> *Id.*, page 24, lines 1 – 2.

<sup>6</sup> Claim 17 states in full:

A **system** for mandatory arbitration resolution regarding one or more unilateral documents comprising:

a **registration module** for enrolling or registering the person who is executing and the one or more unilateral documents in a mandatory arbitration system;

an **arbitration database** for storing arbitration language for insertion in the unilateral document wherein the arbitration language provides that any challenge to the unilateral document must be presented to the mandatory arbitration system for binding arbitration and for providing this arbitration language to the enrolling person;

an **arbitration resolution module** for enabling a complainant to submit a request for arbitration resolution; and

a **means for selecting** an arbitrator from an arbitrator database to conduct an arbitration resolution, for providing support to the arbitrator, and where the arbitrator determines an award or a decision that is final and binding.

*Comiskey*, footnote 3 (emphasis added).

<sup>7</sup> *Supra.*

<sup>8</sup> *Id.*

<sup>9</sup> Claim 17, lines 1 – 3 (emphasis added).

25 “could require the use of a computer<sup>10</sup>” and therefore, encompass patentable subject matter<sup>11</sup>.

Moreover, Claims 17 – 19, 24 and 25 are directed to “‘functional descriptive material’ [i.e., material which] consists of data structures and computer programs which impart functionality when employed as a computer component.<sup>12</sup>” The MPEP is instructive on the pre-*Comiskey* USPTO position on computer program product claims<sup>13</sup>. Furthermore,

a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and **is thus statutory**. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material *per se* from claims that define statutory inventions<sup>14</sup>.

Thus, in interpreting *Lowry*, the MPEP relies on a clear delineation that “**examiners are required or authorized to follow**<sup>15</sup>.” So, with regard to claims 17 – 19, 24 and 25, *Comiskey*, *Lowry* and the MPEP all clearly indicate that a “computer-readable medium

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<sup>10</sup> *Comiskey*, page 22, “Discussion” II C, (“These claims (17 and 46), under the broadest reasonable interpretation, could require the use of a computer as part of *Comiskey*’s arbitration system.”).

<sup>11</sup> *Id.*

<sup>12</sup> MPEP §2106.01.

<sup>13</sup> *Id.*, pg. 2100-17 (When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)(discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory).).

<sup>14</sup> *Id.* §I second paragraph, pg. 2100-18 (emphasis added).

<sup>15</sup> MPEP “Forward”.

encoded with a computer program is a computer element ... **is thus statutory**<sup>16</sup>.”

Therefore, because claims 17 – 19, 24 and 25 recite “a computer usable medium having computer readable program code thereon<sup>17</sup>” that provides “a useful, concrete and tangible result<sup>18</sup>,” claims 17 – 19, 24 and 25 are directed to patentable subject matter under 35 U.S.C. §101. Reconsideration and withdrawal of the final rejection to claims 8 – 25 under 35 U.S.C. §101 is respectfully requested.

Claims 8 – 25 are rejected under 35 U.S.C. §103(a) over U.S. Patent Application No. 2003/00144442 to Shiigi et al. in view of U.S. Patent No. 6,424,980 to Iizuka et al.

Claims 8, 14 and 17 are amended to recite that the raw data is “time-varying data, [and] variable data [is] generated from said time varying data for up to date display; ... .” This is supported by the written description which describes collecting design data during collaborative design and providing updated HTML during the design. See, e.g., paragraphs 0004, 05, 16, 17 and 24. No new matter is added. Claim 17 is (and 18, 19, 24 and 25 are) further, amended to provide antecedent basis for “said computer program product” at line 2.

Without more, text, graphics, video and animation files, previously asserted to be variable data, are not time varying data and combine to provide the same display each time they are combined. Therefore, the combination of Shiigi et al. with Iizuka et al. fails to result in the present invention as recited in any of claims 8, 14 or 17, as amended.

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<sup>16</sup> *Supra.*

<sup>17</sup> Lines 2 – 3.

<sup>18</sup> *Supra.*

Moreover, dependent claims include all of the differences with the references, as the claims from which they depend<sup>19</sup>. Therefore, claims 9 – 13, 15, 16 and 18 – 25 which depend from claims 8, 14 and 17, are non-obvious over Shiigi et al. in combination with Iizuka et al. Reconsideration and withdrawal of the final rejection to claims 8 – 25 under 35 U.S.C. §103(a) is respectfully requested.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance for the reasons set forth above, the applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 8 – 25 under 35 U.S.C. §§101 and 103(a) and allow the application to issue.

As the applicants have previously noted, MPEP §706 “Rejection of Claims,” subsection III, “PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED” provides in pertinent part that

If **the examiner** is satisfied after the search has been completed that patentable subject matter **has been disclosed** and the record indicates that **the applicant intends to claim** such subject matter, he or she may note in the Office action that **certain aspects or features** of the patentable invention have not been claimed and that if properly claimed such claims **may be given favorable consideration**.

(emphasis added.) The applicants believe that the written description of the present application is quite different than and not suggested by any reference of record and that the claims as amended reflect those differences. However, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes.

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<sup>19</sup> MPEP §2143.03 (“If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).”).

AMENDMENT  
August 27, 2008

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Serial No. 10/690,883

Please charge any deficiencies in fees and credit any overpayment of fees to IBM Corporation Deposit Account No. 09-0449 and advise us accordingly.

Respectfully Submitted,

August 27, 2008  
(Date)

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